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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,570	04/22/2004	Steven Jay Lipton	AUS920030571US1	6333
7590 Darcell Walker Suite 250 9301 Southwest Freeway Houston, TX 77074			EXAMINER HU, JINSONG	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 10/29/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/829,570

Applicant(s)

LIPTON ET AL.

Examiner

Jinsong Hu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/22/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-18 are presented for examination.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 11-18 are rejected under 35 U.S.C. 101 because the claimed invention, a computer program in "a computer readable medium", is directed to non-statutory subject matter. Correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 10 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. As per claims 10 and 18, it is uncertain the purpose of periodically checking the message, i.e., for determining whether a response has been sent out to the sender or for the other reason.

Correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al. (US 6,314,454).

9. As per claim 1, Wang teaches the invention as claimed including a method for notifying the recipient of an electronic message mail of a local action required to the contents of the electronic mail message [col. 3, lines 17-26] comprising the steps of:

receiving an electronic message [810, Fig. 8; col. 9, lines 8-10];

determining whether there is a local action required by recipient in response to the contents of the message [col. 7, lines 5-11];

determining whether recipient has performed an action in response to the contents of the message within [col. 7, lines 31-39; col. 9, lines 17-20]; and

transmitting an action completion message to the sender of the original electronic message notifying the sender of the completion of the local action by the recipient [col. 3, lines 5-15; col. 7, lines 39-43; col. 8, lines 35-48].

10. As per claim 11, since it is a computer product claim, it is rejected for the same basis as claim 1 above.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-10 and 12-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (US 6,314,454) as applied to claims 1 and 11 above, in view of Altavilla et al. (US 2002/0194280).

13. As per claims 2 and 3, Wang teaches the invention substantially as claimed in claim 1. Wang does not specifically teach the step of detecting an action-required indicator in the received message. However, Altavilla on the other hand teaches the

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step of detecting an action-required indicator in the received message [pars. 5, 7 & 21].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Altavilla's action indicator in Wang's system because doing so would avoid response delay by reminding the recipient to take action right after aware of the requirement from the sender based on the action indicator. One of ordinary skill in the art would have been motivated to modify Wang's system with Altavilla's action indicator to improve the functionality of the system.

14. As per claims 4-7, Altavilla teaches the invention substantially as claimed in claim 1. Wang does not specifically teaches the step of marking a created message at the message origination location to indicate that an action is required in response to that message. However, Altavilla on the other hand teaches the step of marking a created message at the message origination location to indicate that an action is required in response to that message [pars. 7, 9 & 21]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Altavilla's action indicator in Wang's system because doing so would avoid response delay by reminding the recipient to take action right after aware of the requirement from the sender based on the action indicator. One of ordinary skill in the art would have been motivated to modify Wang's system with Altavilla's action indicator to improve the functionality of the system.

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15. As per claims 8-10, Wang and Altavilla teach the invention substantially as claimed in claim 4. However, both references do not specifically teach the steps of determining a priority for a received message based on the characteristics of the type of action required in the message; and inserting the received message into a priority list of messages, removing a message from the priority list at the completion of an action in response to that message and periodically checking of the message, the frequency of the checks being based on category of the message. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include these message organization functions in Wang's system because they are well-known functions in the art for managing the received and outputted message. One of ordinary skill in the art would have been motivated to modify Wang's system with the management steps to improve the integrity of the message system.

16. As per claims 12-18, since they are computer product claims of claims 2-10, they are rejected for the same basis as claims 2-10 above.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

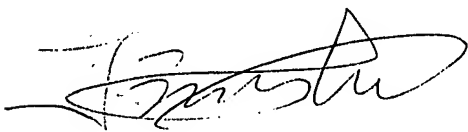
Thro et al. (US 6,147,977) and Heinzl et al. (US 2004/0225718) disclose email alert system.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (571) 272-3965. The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Jinsong Hu', with a stylized, flowing script.

Jinsong Hu

October 25, 2007